



**UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/493,979	06/23/95	SAKUMOTO	K P900-SII
E1M1/0529			EXAMINER
ADAMS 7 WILKS 50 BROADWAY 31 FLOOR NEW YORK NY 10004			MISKA V ART UNIT PAPER NUMBER 15

2112

DATE MAILED: 05/29/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 3/3/97 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), - days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-19 are pending in the application.
Of the above, claims are withdrawn from consideration.
2. ☐ Claims have been cancelled.
3. ☒ Claims 1-4 are allowed.
4. ☒ Claims 5-19 are rejected.
5. ☐ Claims are objected to.
6. ☐ Claims are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. This action is in response to applicants's communications dated 1/27/97, 2/28/97 and 3/3/97.
2. Applicant has amended claims 5 and 6 and filed an unsigned supplemental reissued declaration directed to the amended claims.
3. Claims 1-19 are allowable subject to applicant filing a signed reissue declaration directed to the subject matter of claims 5-19. The previous unsigned declarations filed corresponding to these claims meet the requirements of 37CFR1.175 except for the signatures of applicants.
4. Claims 5-19 are rejected under 35USC251 as being based upon defective reissue declarations for the reasons set forth above.
5. Claims 1-4 are allowed.
6. Applicant's request for an interference with U.S. Patent No. 5,329,501 is noted. An interference based on applicant's proposed count will be declared when the signed reissue declarations are filed by applicant.
7. U.S. Patent No. 5,479,378 issued 12/26/95 to Yamada et al contains at least claim 1 which is not patentably distinct from applicant's claims 5 and 6. The claim is broader than applicant's

claims, however, the differences involve routine circuitry and would be obvious to one skilled in the art at the time of the invention. It is not clear whether Seiko Instruments and Seiko Telecommunication Systems are commonly owned. If commonly assigned, then an obviousness type double patenting rejection will be made, which may be overcome by filing a terminal disclaimer. The interference with the Meister et al patent will then proceed following such filing. If not commonly assigned, then inclusion of the Yamada et al patent in the interference proceedings will be suggested.

8. Commonly assigned patent 5,479,378, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78© and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.


A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Miska whose telephone number is (703) 3096.

VM
May 26, 1997


VIT W. MISKA
PRIMARY EXAMINER
ART UNIT 217